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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,784	11/21/2000	Heli Heiskari	944-003.040	8542

4955 7590 09/13/2004

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EXAMINER

NGUYEN, LE V

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 09/13/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/717,784
Filing Date: November 21, 2000
Appellant(s): HEISKARI, HELI

Ware, Fressola, Van der Sluys & Adolphson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 27, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the claims as listed by the appellant are not separately patentable.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,923,327	Smith et al.	7-1999
6,415,320	Hess et al.	7-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2, 5-6 and 9-10 are rejected under 35 U.S.C. 102(b) as being unpatentable by Smith et al. ("Smith", US 5,923,327).

As per claim 1, Smith teaches a computer-readable medium encoded with a data structure for use in providing a graphical icon for display on a display of a portable communications device, characterized in that the data structure is encoded as digital data indicative of the graphical icon defined by alternating light and dark stripes, that selected stripes of the light and dark stripes change from light to dark and back to light to indicate a shadow adjacent an edge of the icon and from dark to light and back to dark to indicate a highlight adjacent another edge of the icon, and that altogether the light and dark stripes with shadows and highlight provide the icon with a three dimensional appearance (fig. 10; col. 7, line 43 through col. 8, line 6; *users may edit the bits of an icon bitmap*).

As per claim 2, Smith teaches a computer-readable medium characterized in that the data structure is encoded according to a portable bitmap file format (col. 7, line 61).

Claims 5 and 9 are individually similar in scope to claim 1 and are therefore rejected under similar rationale.

Claims 6 and 10 are individually similar in scope to claim 2 and are therefore rejected under similar rationale.

Claims 3-4, 7-8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. ("Smith", US 5,923,327) in view of Hess et al. ("Hess", US 6,415,320 B1).

As per claims 3 and 4, Smith teaches a computer-readable medium characterized in that the data structure is encoded according to a Portable Bitmap file format (col. 7, line 61). Although Smith does not explicitly disclose the file format to be in a Portable Greymap file format or a portable color image file format/Portable Pixmap, Hess teaches a computer-readable medium characterized in that the data structure is encoded in various file formats, including Portable Bitmap file format, Portable Greymap file format and a Portable Pixmap (col. 8, lines 31-47; *PBM/PGM/PPM*). Therefore, it would have been obvious to an artisan at the time of the invention to include Hess' teaching of a computer-readable medium characterized in that the data structure is encoded in various file formats, including Portable Bitmap file format, Portable Greymap file format and a Portable Pixmap to Smith's teaching of a computer-readable medium characterized in that the data structure is encoded according to a Portable Bitmap file

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format in order to contribute to the flexibility of saving images in various file formats and providing an additional convenience to the users, especially given that all of these file formats are art equivalents.

Claims 7 and 8 in combination is similar in scope to the combination of claims 3 and 4 and is therefore rejected under similar rationale.

Claims 11 and 12 in combination is similar in scope to the combination of claims 3 and 4 and is therefore rejected under similar rationale.

(11) *Response to Argument*

Appellant argues:

(a) Though Smith describes editing an icon, they do not describe, mention or even hint at anything about an icon defined by alternating light and dark stripes, much less how these stripes are made to be indicative of highlights and shadows to provide a 3D appearance for icons, "much like a bas-relief". Moreover, "the only evidence the examiner uses to justify the rejection of claim 1 is the appearance of an icon alleging that Smith made this invention 'accidentally' without even knowing or suspecting about it".

(b) It is highly unlikely that somebody of ordinary skill in the art would have been reasonably expected to find the solution claimed without the benefit of hindsight.

(c) Hess does not describe a portable color image file format. The Portable Pixmap described by Hess is not the same as the portable color image file format.

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Per (a) and on the record, appellant's claim that the examiner either supports or affirms appellant's own assumption that Smith's teaching of editing icons was made "accidentally" is false. Smith's invention is not accidental and hardly unsuspecting when he deliberately expounds the editing-an-icon feature to include draw button 1012 and eraser button 1011 (col. 7, line 44 through col. 8, line 10) in order to "[create] a new icon or modify an existing one" (col. 7, lines 50-51). Smith continues with, "Alternatively, rather than using erasure button 1011 or draw button 1012, users may turn on or off *each* bit of the icon simply by touching each block of icon shown in icon editing screen 1010" (col. 10, lines 64-67). Smith's method of creating an icon was applied in forming icons 110, 120 and 130 (figs. 1(A-B) and 2; *for clarity, the examiner has provided a scaled version of 110 and 120 in fig. 2*). A grid was used to demonstrate the scope of creating an icon bit by bit or in this instance, cell by cell.

Clearly, Smith's teaching of editing an icon *bit by bit* is more than just the appearance of an icon as appellant supposes and greater than "some of its bits" as appellant would like to believe; since, drawing or erasing "the bits" of the icon inclusively means *any* of the bits or, if users prefer, *all* the bits.

Furthermore, Smith's bit or bits, being consistent with the definition that a stripe *is* a line wherein a line has a length (and in accordance with elementary math, Smith's bit conforms with the definition of a line/stripe in that a line as it moves towards zero is a point), does have stripes changing from dark stripe to light stripe to dark stripe to indicate a highlight adjacent an edge or another edge of the icon wherein stripes are adjacent to the icon edge (e.g. from left to right of element 1014 of fig. 10, col. 2 depicts

selected stripes of the light and dark stripes change from dark, rows 1-6 of col. 2, to light, row 7 of col. 2, and back to dark, rows 8-14 of col. 2) in order to draw attention to or highlight/emphasize. Smith's edge is consistent with appellant's definition of an edge being "any edge identifying a feature of the icon" (page 10, line 13 of appellant's brief). Moreover, Smith teaches the use of both dark and light edges in that the edges or boundaries of the icon has both dark and light coloring as can be seen in the left edge, top edge and right edge (fig. 10).

And, in as far as appellant's illusion of a three-dimensional appearance for icons is concerned or more accurately that of a raised image of an icon (*or a bas-relief wherein a bas-relief is defined as a relief that projects very little from the background* (appellant's brief: page 10, line 19)), the definition of three-dimensional, i.e. to have or appear to have extension in depth, applies to Smith's icon 1014 as an icon having the appearance of depth (fig. 10; *the image of the house is in bold, giving it a raised look and therefore depth*), a resultant of a combination of light and dark stripes as well as shadows/darkened areas and highlights/emphases.

Per (b), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA

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1971). Smith and Hess teach a computer-readable medium characterized in that the data is encoded in various file formats. Smith's file format is a portable bitmap format (col. 7, line 61). Hess' file format is also a portable bitmap format. Hess then extends his teaching to include encoding the data structure to other file formats such as portable greymap file format and/or portable pixmap (col. 8, lines 31-47; *PGM/PPM*). Hess's teaching that his invention may be implemented using *any* of these file formats is indicative that these formats are considered art equivalents and choosing to encode the data structure in one format over the other would have been just another implementation preference.

Per (c), whether referred to as a portable pixmap or Portable Pixmap (they are one and the same), by definition, is a Portable Pixmap (PPM) is a colour image file format. A PPM file contains the following:

a two character "magic number" - "P3",
the width in pixels,
the height in pixels,
the maximum colour component value,
HEIGHT rows of WIDTH pixels.

The rows are ordered from top to bottom with the pixels in each row ordered from left to right. Each pixel is represented as three values for red, green, and blue. All parts are separated by whitespace and numbers are in decimal ASCII representation. A zero pixel component means that colour is absent. Characters from a "#" to the next end-of-line are ignored and no line should be longer than 70 characters. The following is an example of a small pixmap in this format:

```
P3
# feep.ppm
4 4
15
0 0 0 0 0 0 0 0 15 0 15
0 0 0 0 15 7 0 0 0 0 0
0 0 0 0 0 0 0 15 7 0 0
```

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15 0 15 0 0 0 0 0 0 0 0

A "RAWBITS" variant has magic number "P6", pixel values are stored as plain binary bytes, instead of ASCII decimal and no whitespace is allowed after a single whitespace character after the maximum colour component value which must be less than or equal to 255.

Furthermore, Hess' portable pixmap is consistent with the definition of a portable colour image file format found on page 6 of lines 7-11 in Appellant's specification, which states: "the data structure stored in the computer-readable medium may be encoded according to a portable bitmap file format known in the art as 'pbm'... Alternatively, the structure can be encoded with other formats, such as 'pgm' for portable graymap file format, or 'ppm' for portable pixmap file format (*lowest common denominator color image file format*)". Therefore, the modified Smith's portable pixmap is a portable colour image file format, otherwise Appellant's arguments is contrary to appellant's own words that the lowest common denominator color image file format is a Portable Pixmap.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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LVN
August 20, 2004

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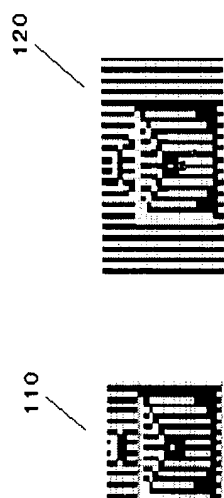


FIGURE 1A



FIGURE 1B

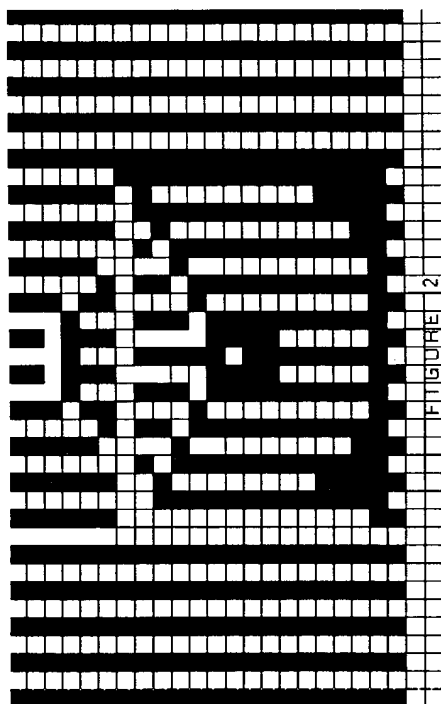


FIGURE 2